

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed May 15, 2006. Claims 1, 10, and 31 have been amended and new claim 36 has been added. Claims 1-6, 8-26 and 28-36 remain pending. Support for the amendments and new claim is found in the specification, claims, and drawings as originally filed. No new matter has been added. Reconsideration and reexamination are respectfully requested.

Rejection under 35 U.S.C. § 102(b)

Claims 1-13, 15-17, 20-22, 25, and 26 remain rejected as being anticipated by Melchione et al. (US 5,930,764). Applicants must respectfully traverse this rejection. Independent claims 1 and 10, as amended, recite in part, the method steps of providing a customized listing of customers to at least select representatives, and at least some of the representatives sending or providing the marketing material to at least some of the customers listed on their customized listing, wherein at least part of the marketing material includes textual matter.

As can be seen, claims 1 and 10 recite methods in which a representative makes the determination of which of his/her customers are to receive marketing material. Melchione does not appear to teach such a method. Melchione specifically teaches "branch managers assign the leads to the personal bankers most qualified to handle the leads, or based on the workload and availability of the personal bankers." See column 9, lines 49-52. In the method of Melchione, it appears that the branch managers make the determination of which of the bank's customers are to be represented by particular representatives for a particular marketing project. Melchione also state that a "list of leads are used to target a direct mailing to the customers or households that meet the specific selection criteria for the sales campaign, or the list of leads is sent directly to the CCIS for telemarketing." See column 9, lines 9-12. Note that because the direct mailing is taught as an alternative to sending leads to the CCIS for telemarketing, the direct mailing would appear to be carried out by the micromarketing center rather than personal bankers. As such, Applicants do not believe it can readily be argued that Melchione teach a method in which each

representative represents particular customers, and the representative determines which of his/her customers are to receive marketing material and the representative sends the material.

In addition, the Examiner takes the position that Melchione teaches a method in which the banker sends marketing material via telephone calls. As noted above, claims 1 and 10, as amended, each recites that at least part of the marketing material includes textual matter. Melchione's teaching of bankers calling customers does not anticipate the claimed method step of representatives providing marketing material, wherein at least part of the marketing material includes textual matter. Transmitting the voice of a bank representative over the phone is clearly not equivalent to sending marketing material that includes textual matter, as now recited in claims 1 and 10.

Moreover, claim 10 recites that the marketing material is personalized to at least appear to be from the representative. Melchione does not appear to teach, disclose or suggest providing marketing material that includes textual matter and that is personalized to at least appear to be from the representative. For these and other reasons, claims 1 and 10 are believed to be clearly patentable over Melchione. For similar and other reasons, dependent claims 2-6, 8-9 and 11-24 are also believed to be clearly patentable over Melchione.

Independent claim 25 recites, in part, the steps:

- providing a marketing project having a number of marketing project parameters;
- applying the number of marketing project parameters against the information in the customer database to identify selected customers;
- providing a notice announcing the marketing project to one or more of the representatives;
- at least some of the representatives reviewing the notice and requesting a customized listing that includes a listing of the portion of the selected customers that are represented by the representative; and
- determining a marketing project appeal indicator by monitoring how many representatives reviewed the notice and requested a customized listing.

The claimed method thus involves a representative reviewing the notice and choosing to request a customized list of his/her customers who are among the selected customers. The marketing

project appeal indicator is then determined based on how many representatives reviewed the notice and requested a customized listing. Melchione does not appear to teach or suggest such method steps.

The Examiner asserts that Melchione teaches the claimed method steps in teaching the bank management deciding on a sales promotion or marketing project and informing the marketing center such that leads can be generated and sent to the bankers at the branches. Applicants submit that Melchione's teaching of bank management informing a marketing center to send leads to a banker does not anticipate the claimed method steps of at least some of the representatives reviewing a notice announcing the marketing project and requesting a customized list of their customers. In the method of Melchione, a notice announcing a marketing project does not appear to be provide to one or more of the bank representative. Nor does it appear that at least some of the bank representatives review the notice and request a customized listing that includes a listing of the portion of the selected customers that are represented by the bank representative, as recited in claim 25. As described above, it appears that the bank management determines which bankers get which leads.

The Examiner also asserts that Melchione's teaching of tracking the results of the sales promotion inherently means the representatives were notified of the promotion since they are contacting customers to sell it. Applicants respectfully submit that the bankers merely being notified of a promotion does not anticipate the claimed method step of at least some of the representatives reviewing a notice and requesting a customized listing of customers.

The Examiner also asserts that the marketing appeal indicator of claim 25 is a measure of the performance of the marketing plan and is equivalent to Melchione's tracking the performance of the campaign since it performs an identical function in substantially the same manner with substantially the same results. Applicants respectfully disagree. Claim 25 recites a method requiring specific method steps. The Examiner appears to be equating the system of Melchione with the instant claims. MPEP 2131 states that, in order to anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v.*

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Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." Applicants submit that in order to anticipate a method claim, a reference must teach method steps in as complete detail as in the claim. Melchione does not teach the method steps recited in claim 25.

Moreover, the steps of capturing daily sales information and viewing sales results for various campaigns taught by Melchione (column 10, lines 1-6) do not perform an identical function or have substantially the same results as the claimed method step of determining a marketing project appeal indicator by monitoring how many representatives reviewed the notice AND requested a customized listing. Melchione does not teach the steps of monitoring bankers who review a notice. Instead, Melchione appears to teach the marketing material being provided automatically from the micromarketing center. Further, Melchione does not appear to teach or suggest the step of monitoring how many representatives requested a customized listing of customers. As stated above, Melchione appears to teach the micromarketing center distributing leads to bankers according to branch managers' directions. Melchione thus does not teach or suggest the specific method steps recited in independent claim 25.

Dependent claim 26 specifies that the customized listing of selected customers is provided to one or more of the representatives upon initiation by the representative. The Examiner asserts that Melchione teach, in FIG. 1A, the Micromarketing centers as requesting information from the database to obtain the customer information, and asserts that the micromarketing center is the "representative." Independent claim 25, from which claim 26 depends, recites "each representative represents a portion of the customers", and the Examiner previously asserted that the personal bankers of Melchione are equivalent to the "representatives" in the claims. Applicants submit that the micromarketing center taught by Melchione is not equivalent to the "representatives" in the claimed methods because Melchione teaches the micromarketing center as providing information to the personal bankers, who then contact customers. Melchione does not appear to teach or suggest the personal bankers initiating a customized listing of customers to be sent to them. Melchione thus does not appear to teach or suggest the elements of claim 26.

Regarding claim 29, the Examiner asserts that Melchione's teaching that leads are distributed among selected bankers within the branch anticipates the method step of providing a customized listing of selected customers to a particular representative where the list only includes customers that the particular representative represents. Applicants respectfully disagree. Melchione teaches the branch manager determining which banker gets which leads based on which banker is most qualified to handle the leads or based on the workload and availability of the bankers. See column 9, lines 49-52. Melchione thus appears to teach a branch bank with a set of customers, and the bank managers decide which customers are to be handled by certain bankers, where the particular set of customers being contacted by a particular banker changes depending the banker's availability or qualifications. Melchione does not appear to teach a method in which each customer is represented by a particular representative, and the representative receives a listing of customers for which the marketing material is particularly relevant, where the only customers on the list are those that the representative already represents, as in claim 29. Thus, while all of selected customers on the list generated based on the marketing project parameters are customers of the business, a subset of those customers are represented by a particular representative, and the method of claim 29 states that the customized listing of customers provided to a particular representative includes only those customers already represented by that representative. Melchione does not teach or suggest such a method.

For at least the reasons set forth above, Melchione does not appear to teach or suggest each and every element recited in independent method claims 1, 10, and 25, or the claims dependent thereon. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 14, 18, 23, and 24 are rejected as being unpatentable over Melchione et al. For at least the reasons set forth above, Melchione does not appear to teach or suggest the basic elements of independent claim 10, from which claims 14, 18, 23, and 24 depend. Additionally,

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there is no motivation for one of ordinary skill in the art to modify the method of Melchione to achieve the specific method steps recited in the claims.

Claims 19 and 31-35 are rejected as being unpatentable over Melchione et al. in view of 17 CFR Part 24. Applicants respectfully traverse the rejection.

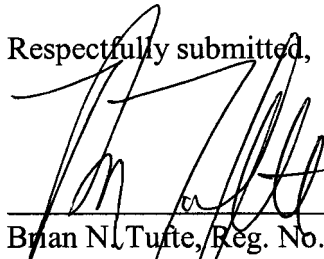
With respect to dependent claim 19, for at least the reasons stated above, Melchione does not appear to teach each and every element of independent claim 10, from which claim 19 depends. 17 CFR Part 24 does not appear to provide what Melchione lack. Thus, even if one were to combine Melchione and 17 CFR Part 24, one would not arrive at the claimed invention. Additionally, there does not appear to be any motivation for combining the teachings of Melchione and 17 CFR Part 24. The Examiner asserts that the motivation to combine the references is the fact that federal law requires adherence to the regulations. Applicants submit that the mere presence of regulations relating to consumer privacy does not provide any motivation, guidance or suggestion for one of ordinary skill in the art to modify the database of Melchione.

Independent claim 31, as amended, recites in part, the steps of generating marketing material, wherein at least part of the marketing material includes textual matter, checking the marketing material for compliance, and representatives providing the compliant marketing material to at least some of the customers on their customized listing of selected customers. As stated by the Examiner, Melchione teaches the personal bankers conducting sales calls with customers. Melchione does not appear to teach a method in which textual marketing material is checked for compliance and then bankers providing the textual marketing material to their customers. The 17 CFR Part 24 regulations do not provide what Melchione lack, thus any combination of Melchione and the regulations also fails to teach or suggest each and every element of independent claim 31 or the claims dependent thereon. Withdrawal of the rejection is respectfully requested.

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Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims are now in condition for allowance. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-359-9348.

Respectfully submitted,



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